



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Keats A. Quinalty
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
P.O. BOX 7037
ATLANTA GA 30357-0037

MAILED AUG 10 2006

In re Application of: ZOECKLER :
Appl. No.: 09/818023 : DECISION ON PETITION
Filed: March 27, 2001 :
For: PAPERBOARD CARTONS WITH LAMINATED :
REINFORCING RIBBONS AND TRANSITIONED :
SCORES AND METHOD OF MAKING SAME :

This is a decision on the petition filed on March 31, 2005 by which petitioner requests reconsideration of the examiner's refusal to enter a "supplement to the appeal brief". The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner filed a notice of appeal and subsequently filed an appeal brief on November 3, 2003. An examiner's answer was entered into the record on December 1, 2003. A "reply brief" was received by the office on March 16, 2004 and denied entry as being untimely in the Decision on Petition of August 18, 2004. A "supplement to the appeal brief" was received on September 24, 2004. This supplement was denied entry *without explanation* in the Office letter mailed March 22, 2005. Petitioner timely filed a request for reconsideration on March 31, 2005 and the application stands remanded to the examiner by the Board for a determination of the results of the request for reconsideration.

The paper in question contains no new arguments or positions that would require consideration by the examiner. The paper merely updates the real party-in-interest and summary of related appeals sections of the prior Brief. Petitioner opines the "supplement to the appeal brief" must be entered as it "merely apprises the Board of Appeals of the current assignee of the present application and updates the status of related appeals and interferences, both of which are required under new Part 41 of the Rules of practice". Therefore petitioner submits the supplement must be entered.

In looking to new Part 41 of the Rules of practice, the applicable rule referred to by petitioner is 37 CFR 41.8(a)(1) and (2) which states in part:

37 CFR 41.8. Mandatory notices.

(a) In an appeal brief (§ § 41.37, 41.67, or 41.68) or at the initiation of a contested case (§41.101), and within 20 days of any change during the proceeding, a party must identify:

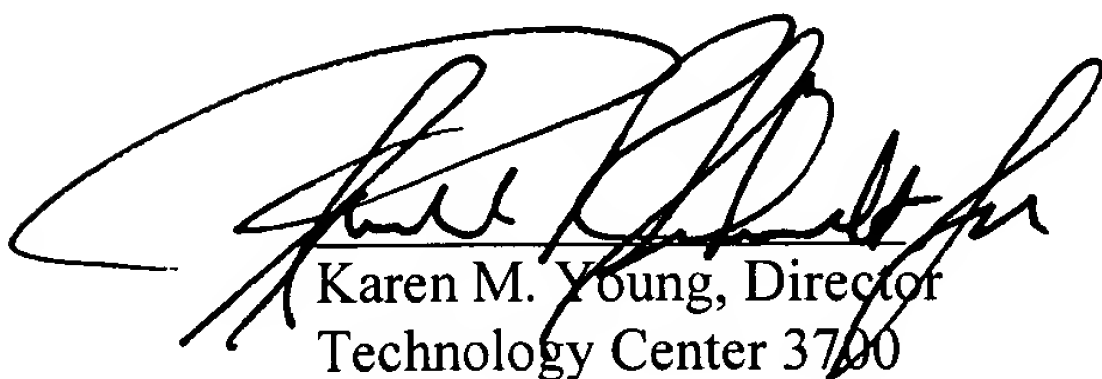
- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

As the knowledge of the real party-in-interest allows the Board to avoid the appearance of any conflict of interest in assigning workload, and awareness of related cases facilitates scheduling and panel assignment which increases efficiencies as well as affords access to related decisions which may have bearing upon the appeal, appellants have a duty to make such mandatory notices in their appealed applications. The examiner is without authority to deny entry of mandatory notices under this rule. While identification of the notice as being a mandatory notice filed under 37 CFR 41.8 may have avoided confusion and delay, the "Supplement to Appeal Brief" is not a "Supplemental Appeal Brief" as purported by the examiner and entry is allowed.

In the Remand, the Board asks the examiner for a final determination of the status of both the "reply brief" and the "supplement to appeal brief". This application is being returned to the examiner of record for issuance of a formal indication that the "supplement to appeal brief" or mandatory notice filed on September 24, 2004 is entered to the record, while the "reply brief" of March 16, 2004 remains un-entered per the Decision of August 18, 2004. The application will then be returned to the Board for consideration of the appeal.

Any questions regarding this petition decision should be directed to Jessica Harrison, Technology Center 3700 Special Programs Examiner at 571-272-4449.

PETITION GRANTED



Karen M. Young, Director
Technology Center 3700